

### **REMARKS**

This amendment is being filed in response to the Final Office Action mailed August 12, 2003. This response, which is being filed on or prior to November 12, 2003, is to be considered timely filed.

Please make of record the following comments and amendments.

Claims 1-30 are pending in the application. Claims 25-30 have been withdrawn from consideration. Claims 1-8, 10-12 and 14-23 are rejected. Claims 9, 13 and 24 are objected to. Claims 25-30 have been canceled. No claims have been allowed.

#### **Restriction Requirement**

Previously, a restriction requirement was sent on June 1, 2003. Said restriction requirement was unclear in describing the status of claims 28-30. In response to the June 1, 2003 restriction requirement, applicants had asked the Examiner to clarify the status of said claims. In a phone call to applicants' attorney, William Lee, on or about August 7, 2003, the Examiner stated that the restriction requirement would be revised to include claims 28-30.

In response to the revised restriction requirement mailed on August 12, 2003 for the above-identified application, applicants respond as follows.

Claims 1-30 are pending in the application. The Examiner restricted the claims into five major groups:

Group I (claims 1-24 drawn to a process of making bicyclotetrazine of formula I shown in claim 1 and a process for making its intermediates);

Group II (claims 18-20 and 26 drawn to compounds of formula II, II V and compounds 5,6, 8 and their acid addition salts);

Group III (claims 18-20 and 25-26, drawn to compound of formula VI and compound 4 and its acid addition salt)

Group IV (claims 18-20 and 27, drawn to compound of formula IV and compound 13 and its acid addition salt)

Group V (claims 20 and 26, drawn to compound 17 and its acid addition salt)

Group VI (claims 28-29, drawn to the process of making 4-amino-5-imidazole carboxamides)

and

Group VII (claim 30, drawn to the process of making carboxamide-type compounds).

The Examiner advised applicants to elect a Group to be examined and to identify the claims reading thereon.

As stated in the prior response to the restriction requirement, Applicants are puzzled by the restrictions of the claims by the Examiner and believe that claims 1-30 form part of one and the same invention.

Applicants maintain that when there is a linking claim encompassing the scope of all the compounds, and process of preparing them, it is inappropriate to restrict the invention to a single compound. Applicants also believe that due to such commonality, a complete examination of claims 1-30 would not cause undue burden. Applicants further believe that the same art search will most probably apply to the alleged separate inventions. Reconsideration and withdrawal of the restriction requirement are, therefore, respectfully requested.

However, for the sake of facilitation of prosecution and in order to comply with the Examiner's requirement, applicants elect the claims that the Examiner has identified as belonging to Group I (claims 1-24) with traverse and applicants have canceled claims 25-30.

#### **Allowable Subject Matter**

The Examiner stated that claims 9, 13 and 25 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### **Claim Rejections - 35 USC § 103**

The Examiner stated that Claims 1-8, 10-12 and 14-23 are rejected under 35 U.S.C. 103(a) as being unpatentable Baig et al. (Baig) GB 2 125 402 and the secondary reference Chabala et al EP 0113,570 for reasons of record.

The Examiner stated that Baig discloses a compound of formula I and a process to make said compound.

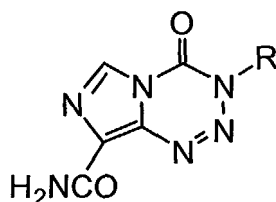
The Examiner stated that Chabala et al. discloses imidazole compounds, specifically on page 2, page 9, scheme 2 and examples 1-4 of Table 1.

In response, applicants respectfully traverse the Examiner's rejection and provide the following comments.

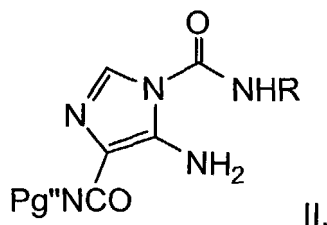
Utilizing the **Graham** factors in an obviousness analysis, applicants respectfully suggest that under the first (scope and contents of prior art) and second factor (ascertaining the differences between prior art and claims at issue), a finding of obviousness cannot be made in the present case. (See **Graham v. John Deere Co.**, 383 U.S. 1, 148, U.S.P.Q. 459 (1966)).

The Examiner noted that the instant claims differ from Baig in reciting the Pg" as protecting groups. In contrast, Baig includes them as groups whose presence also results in claimed activity. Also, the Examiner noted that the claims of the instant invention require a process of making an imidazole intermediate. Unlike the claimed invention, Baig does NOT mention any type of imidazole intermediates. Accordingly, per the first and second **Graham** factors, the differences in scope between the present invention and Baig, preclude a finding of obviousness for claims 1-8, 10-12 and 14-23. Therefore, Baig cannot be relied upon in an obviousness rejection against the claimed invention.

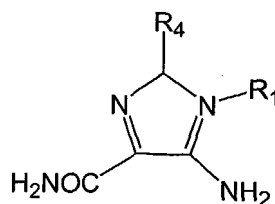
Further, applicants respectfully state that the present invention is not obvious in light of Chabala et al. The claimed invention is directed to the preparation of a compound of formula



from a compound of formula II



In contrast to the applicants' compound of formula II, Chabala's table 1 discloses a compound of formula



wherein R<sub>1</sub> is a substituted **benzyl** ring.

Applicants point out that like the Baig reference, the Chabala reference fails to teach protecting groups such as PG". Further, applicants respectfully note that Chabala et al. do not teach the claimed process as summarized above. Chabala's reaction scheme 2 on page 9, merely shows the formation of an imidazole type compound. Further, the imidazole type compounds of Chabala's table 1 are not the same type of compounds disclosed by applicants. Chabala's compounds differ by the fact that they are substituted at the nitrogen position (R<sub>1</sub>) with substituted **benzyl** rings. In contrast, applicants' formula II disclose **carboxamides** as substituents on the nitrogen. Applicants suggest that Chabala's teaching of substituted rings teaches away from applicants' claimed invention. Therefore, the differences in scope between the present invention and Chabala, preclude a finding of obviousness for claims 1-8, 10-12 and 14-23.

In addition, it is noted that there is no motivation or suggestion in either reference to combine the compounds of Baig, with the imidazoles of Chabala, to render the claimed invention obvious. As stated above, the differences in scope between Baig and Chabala and the claimed invention, preclude a finding of obviousness. These differences also preclude one of ordinary skill in the art to combine the two references to render applicant's invention obvious. Therefore, based on this lack of motivation and/or suggestion to combine and the comments provided above, applicants respectfully request the withdrawal of this rejection.

No fees are believed to be due with this amendment. If any fees are determined to be due by this paper, the Commissioner is hereby authorized to deduct such fees from Account No. 19-0365.

In re Application of: **KUO** et al.  
Serial No.: 10/050,488  
Filed: 01/16/2002

The Examiner is requested to call the undersigned attorney on any matter connected with this application.

Respectfully submitted

A handwritten signature in black ink, appearing to read "William Y. Lee", is written over a horizontal line.

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